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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/665,754

09/19/2003

James J. Pagliuca

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05/07/2007

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EXAMINER

NGUYEN, VI X

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

05/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/665,754

**Applicant(s)**

PAGLIUCA ET AL.

**Examiner**

Victor X. Nguyen

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/19/03; 4/5/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) received on 9/19/2003 and 4/5/2004, is acknowledged. The submission is in compliance with the provision of 37 CFR 1.97.

Accordingly, the information disclosure statement is being considered by the examiner.

### *Oath/Declaration*

2. It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56. Specifically, the oaths/declarations do not have the correct statement with respect to the duty to disclose. The correct statement should read "I acknowledge the duty to disclose information which is material to patentability of this application in accordance with Title 37, Code of Federal Regulations Section 1.56."

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 11, 13 of U.S. Patent No. 6,652,553.

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the same subject matters as following: surgical tool for use in expanding a tubular structure or a cannula comprising: a tubular structure or a cannula has an inner surface defining a passage through the tubular or the cannula for receiving surgical instruments, the surgical tool comprises a first leg having a first end, a second leg has a second end, and where the first and the second ends being moveable away from each other to apply a radially outwardly directed force to the inner surface of the tubular structure or the cannula. As to claims 3, 9 are not patentably distinct from each other because they are essentially the same as those in the cited patent.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5,7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Zhu et al. (5,577,993).

Zhu et al disclose in figures. 2, 4 and 6, a surgical tool 20 for use in expanding a tubular structure as recited in claims 1-2,4 including: a first leg 54 has a first end 51a, a second leg 54 has a second end 51b, where the first and the second end is moveable away from each other at best seen in fig. 5, and where the tool further includes an actuator 55 which is able to move the first and the second legs away from each other (fig. 4). Regarding the intended use” a surgical tool *for use in expanding a tubular structure*, the tubular structure having an inner surface

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defining a passage through the tubular structure *for receiving surgical instruments*, said first and second ends *being moveable away from each other to apply a radially outwardly directed force to the inner surface of the tubular structure* and cause expansion of the tubular structure *to increase a cross-sectional area of the passage along a portion of the passage*; The statement of intended use and other functional statements have been carefully considered but are deemed not to impose any structure limitations on the claims distinguishable over Zhu reference which is capable of being used as claimed if one desires to do so.

As to claim 3, Zhu et al disclose a first and second handles (56), where the handles move toward each other to move the first and second legs (54) away from each other (fig.5).

As to claims 5 and 7, Zhu et al disclose a member or a depth limiter (element 64 is considered a member or a depth limiter, see col. 9, lines 14-18) which is able for limiting the depth as the surgical tool extends into the passage in the tubular structure or is able to limit the distance of the legs move away from each other.

As to claim 9, it noted that fig. 2 of Zhu clearly defined element 56 as first and second handles *being movable toward each other to pivot said first and second legs relative to each other and move said first and second ends away from each other* (a functional limitation): Thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. Accordingly, the reference is considered to read on the claimed limitation of the claimed noted.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu et al (5,577,993).

Regarding claims 6 and 8, Zhu discloses the invention substantially as claimed. Zhu is silent that the device further comprises a depth limiter or a member includes a plurality of positions along the surgical tool to define a plurality of depths or distances that the tool extends into the passage. Instead, Zhu indicates that the device has a stop device 64 which provides an effective impediment to excessive travel and penetration of the trocar 40 (see col. 9, lines 13-17)

At the time the invention was made, it would have been obvious matter of design choice to a person of ordinary skill in the art to modify Zhu's device with a depth limiter or a member includes a plurality of positions along the surgical tool to define a plurality of depths or distances because Applicant has not disclosed that a depth limiter or a member includes a plurality of positions along the surgical tool to define a plurality of depths or distances provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Zhu device, and applicant's invention, to perform equally well with either the device taught by Zhu because both device would perform the same function of providing additional safety and control to the instrument during surgical procedures.

Therefore, it would have been obvious to modify Zhu to obtain the invention as specified in the above claims because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Zhu.

### ***Conclusion***

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,432,048 to Francois      U.S. Pat. No. 5,813,978 to Jako

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor X Nguyen  
Examiner  
Art Unit 3734



VN  
4/27/2007